UNITED STATES PATENT AND TRADEMARK OFFICE

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22   DECISION ON APPEAL

23   STATEMENT OF THE CASE

24   Arthur Koeppel and Jonathan Turner (Appellants) seek review under

25   35 U.S.C. § 134 of a final rejection of claims 40-46, 48-57, 59-68, and 70-72, the

26   only claims pending in the application on appeal.

27   We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

28
29   We AFFIRM-IN-PART.

1   The Appellants invented a web based marketing method and system for

2 monitoring and collecting user responses to web based content provided

3 (Specification 2:3-5).

4   An understanding of the invention can be derived from a reading of exemplary

5 claim 40, which is reproduced below [bracketed matter and some paragraphing

6 added].

7   40. A method for performing dynamic Web-based in- view
8   monitoring, the method comprising:

9   [1] appending a client side routine to a Web page provided by a Web
10   server, wherein the Web page includes content data;

11   [2] sending the Web page to a plurality of client nodes; and

12   [3] displaying the Web page to a plurality of users located at
13   respective client nodes, and in response to the Web page being
14   displayed to each user, each client node initiating the client side
15   routine to perform the following:

16   [4] detecting in-view user activities associated with each
17   respective user browsing the Web page, wherein the in-view
18   user activities are associated with in-view response data
19   reflecting whether or not the content data was viewable or
20   partially viewable to each respective user;

21   [5] collecting data reflecting the in-view user activities, wherein
22   the collected data includes information indicating the
23   proportion of content actually viewable to a respective user;

24   [6] detecting a client side trigger event; and

25   [7] sending the collected data to the Web server in response to
26   the detected client side trigger event; and

27   [8] analyzing the collected data to determine user in-view
28   characteristic data reflecting whether the content was viewable
29   or partially viewable by the respective user.

30

1   This appeal arises from the Examiner's final Rejection, mailed October 20,

2   2004. The Appellants filed an Appeal Brief in support of the appeal on July 13,

3   2005. An Examiner's Answer to the Appeal Brief was mailed on September 5,

4   2007. A Reply Brief was filed on October 2, 2007.

5   PRIOR ART

6   The Examiner relies upon the following prior art:

   Himmel   US 6,317,782 B1   Nov. 13, 2001
   Mason   US 6,401,075 B1   Jun. 4, 2002

7   REJECTION

8   Claims 40-46, 48-57, 59-68, and 70-72 stand rejected under 35 U.S.C. § 103(a)

9   as unpatentable over Mason and Himmel.

10   ISSUE

11   The issue pertinent to this appeal is whether the Appellants have sustained their

12 burden of showing that the Examiner erred in rejecting claims 40-46, 48-57, 59-68,

13 and 70-72 under 35 U.S.C. § 103(a) as unpatentable over Mason and Himmel.

14   The pertinent issue turns on whether Himmel describes information indicating

15 the proportion of content actually viewable to a respective user.

16   FACTS PERTINENT TO THE ISSUES

17   The following enumerated Findings of Fact (FF) are believed to be supported

18 by a preponderance of the evidence.

19   *Facts Related to Claim Construction*

20   01.   The disclosure contains no lexicographic definition of "append."

1   02.   The ordinary and customary meaning of "append" is to fix to or

2   attach.[1]

3   *Mason*

4   03.   Mason is directed to obtaining internet advertisements, modifying

5   those advertisements to fit the designated advertising spaces allotted by a

6   different and unrelated online newspaper websites, automatically placing

7   those advertisements, monitoring the success of the placed ads and

8   modifying the ads and their placements to meet dynamic goals of an

9   advertising campaign (Mason 2:5-12).

10   04.   Mason describes using a statistical analysis package to monitor and

11   report the success of on-line advertisements and their derivative

12   advertisements (Mason 6:27-65).

13   05.   Mason describes billing an advertiser for an online newspaper ad

14   (Mason 5:4-9).

15   *Himmel*

16   06.   Himmel is directed to detecting the actual viewing of advertisements

17   contained on web pages, recording the detected information, and

18   transmitting the recorded information when necessary through Java

19   Applets in combination with JavaScripts and cookies (Himmel 3:57-62).

20   07.   During the downloading of web page, a Java Applet (Advertisement

21   Control Module) is also downloaded and executed. The Advertisement

22   Control Module 604 is responsible for displaying the web page including

23   its associated contents, controlling all related movement of web page,

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[1] *American Heritage Dictionary of the English Language* (4th ed. 2000).

1   detecting when an advertisement is viewable, and invoking a

2   corresponding JavaScript to record pre-selected intervals for which the

3   associated advertisement was visible (Himmel 8:19-27).

4   08.   The term viewable in Himmel defines when a particular advertisement

5   is completely or identifiably (i.e. partially but not completely) seen by

6   the end user. The particular method or statistics used for such

7   determination are most likely to be negotiated between the parties, and

8   therefore, definable based upon these negotiations. As each

9   advertisement becomes viewable, the Advertisement Control Module

10   detects this visibility and begins to time the viewable event. If

11   the viewable event exceeds a pre-selected time interval, then the

12   Advertisement Control Module invokes the corresponding JavaScript.

13   If the user is still connected to the Internet, then JavaScript transmits the

14   time interval and other relevant information to the corresponding server

15   (Himmel 8:44-65).

16   *Facts Related To The Level Of Skill In The Art*

17   09.   Neither the Examiner nor the Appellants has addressed the level of

18   ordinary skill in the pertinent arts of systems analysis and programming,

19   commercial transaction systems, and network communication. We will

20   therefore consider the cited prior art as representative of the level of

21   ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355

22   (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill

23   in the art does not give rise to reversible error 'where the prior art itself

24   reflects an appropriate level and a need for testimony is not shown'")

1   (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d

2   158, 163 (Fed. Cir. 1985).

3   *Facts Related To Secondary Considerations*

4   10.   There is no evidence on record of secondary considerations of non-

5   obviousness for our consideration.

6   PRINCIPLES OF LAW

7   *Claim Construction*

8   During examination of a patent application, pending claims are given

9   their broadest reasonable construction consistent with the specification. *In*

10   *re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci.*

11   *Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

12   Limitations appearing in the specification but not recited in the claim are not

13   read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.

14   Cir. 2003) (claims must be interpreted "in view of the specification" without

15   importing limitations from the specification into the claims unnecessarily).

16   Although a patent applicant is entitled to be his or her own lexicographer of

17   patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,

18   347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such

19   definitions in the Specification with sufficient clarity to provide a person of

20   ordinary skill in the art with clear and precise notice of the meaning that is to be

21   construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although

22   an inventor is free to define the specific terms used to describe the invention, this

23   must be done with reasonable clarity, deliberateness, and precision; where an

24   inventor chooses to give terms uncommon meanings, the inventor must set out any

1   uncommon definition in some manner within the patent disclosure so as to give

2   one of ordinary skill in the art notice of the change).

3   *Obviousness*
4
5   A claimed invention is unpatentable if the differences between it and the

6   prior art are "such that the subject matter as a whole would have been obvious at

7   the time the invention was made to a person having ordinary skill in the art."

8   35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30

9   (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

10   In *Graham*, the Court held that that the obviousness analysis is bottomed on

11   several basic factual inquiries: "[(1)] the scope and content of the prior art are to be

12   determined; [(2)] differences between the prior art and the claims at issue are to be

13   ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." 383

14   U.S. at 17. *See also KSR Int'l v. Teleflex Inc.*, 127 S.Ct. at 1734. "The

15   combination of familiar elements according to known methods is likely to be

16   obvious when it does no more than yield predictable results." *KSR*, at 1739.

17   "When a work is available in one field of endeavor, design incentives and

18   other market forces can prompt variations of it, either in the same field or a

19   different one. If a person of ordinary skill can implement a predictable variation,

20   § 103 likely bars its patentability." *Id*. at 1740.

21   "For the same reason, if a technique has been used to improve one device,

22   and a person of ordinary skill in the art would recognize that it would improve

23   similar devices in the same way, using the technique is obvious unless its actual

24   application is beyond his or her skill." *Id*.

1   "Under the correct analysis, any need or problem known in the field of

2   endeavor at the time of invention and addressed by the patent can provide a reason

3   for combining the elements in the manner claimed." *Id.* at 1742.

4   ANALYSIS

5   *Claims 40-46, 48-57, 59-68, and 70-72 rejected under 35 U.S.C. § 103(a) as*

6   *unpatentable over Mason and Himmel.*

7   The Appellants argue claims 40-42, 51-53, and 62-64 as a group (Br. 2: ¶ 1).

8   Accordingly, we select claim 40 as representative of the group.

9   37 C.F.R. § 41.37(c)(1)(vii) (2007).

10   The Examiner found that Himmel described all of the limitations of claim 40

11   except that of modifying the content of the web page based on the user in-view

12   characteristic data. As there is no limitation reciting such modification, we take

13   the Examiner to mean the limitations of response data reflecting whether content

14   was partially viewable in limitation [4]. The Examiner found Mason described

15   such modification, and provided the motivation for adding this to Himmel (Answer

16   3-4).

17   The Appellants contend that neither reference describes collecting data

18   reflecting in-view activities associated with in-view response data reflecting

19   whether or not the content data was viewable or partially viewable to each

20   respective user. The Appellants argue that Himmel collects data reflecting the

21   amount of time an advertisement is visible and this cannot reasonably be construed

22   as information indicating the proportion of content actually viewable to a

23   respective user (Br. 3). The Appellants further argue that the plain language of the

24   claim and the context of the language in the specification preclude interpreting the

1   viewable limitation as an amount of time content is visible (Br. 4). They go on to

2   also argue that Himmel's tracking of time is not tracking a proportion of content

3   and that comparing the amount of time of two separate viewing events does not

4   demonstrate collecting data reflecting the proportion of content actually visible

5   (Br. 5).

6   The Examiner responds that claim 40 does not specify the attributes of the ad

7   that are measured, only that the information indicates the proportion of content

8   actually viewable, and that the amount of time viewable out of total time is such a

9   proportion (Answer 7).

10   We agree with the Examiner. Claim 40 requires collecting data that includes

11   information indicating the proportion of content actually viewable to a respective

12   user. Himmel does so (FF 07 & 08). The limitation does not further limit the

13   manner or nature of the property of being viewable. The Appellants are

14   contending a limitation that does not exist in the claim.

15   The Appellants make two subordinate arguments that Himmel does not analyze

16   its tracked time data (Br. 18), and that Himmel only tracks the time that an ad is

17   visible, not partially visible, citing Himmel 8:50-53 (Br. 20). However, Himmel

18   explicitly recites applying statistics to its collected data (FF 08), as does Mason

19   (FF 04), which is to perform analysis. As to the second argument, we find that the

20   cited portion of Himmel describes a simplifying assumption ("It will be assumed

21   …" Himmel 8:50) about the set of data Himmel uses in an example, and does not

22   suggest that Himmel's system would record only those times an ad was completely

23   visible in general.

24   As to the Appellants' argument that tracking time is not tracking a proportion,

25   we find that the claim calls for information indicating the proportion of content

9

1 actually viewable, not for a proportion itself. Himmel describes using statistics for

2 such a determination (FF 08), and a proportion is a notoriously well known and

3 predictable statistic. Further, since Himmel forwards the timing data after a

4 specific time interval, the data that is passed implicitly includes that time interval

5 as a parameter, and the proportion would be the ratio of the time measured to the

6 time limit triggering the data transmission.

7 The Appellants separately argue claims 43-46, 48, and 50.

8 Claim 43 requires that the client side routine be appended to a URL on a web

9 page. Claims 44-46 require that each trigger event be associated with the client

10 side data store filled above a threshold (claim 44); closing a browser application

11 (claim 45); and a user selecting a URL displayed on the web page (claim 46).

12 Claim 50 requires the in-view activities be mouse pointer position data. For each

13 of these limitations, the Examiner found that the breadth of the claim allowed that

14 limitation to be found in Himmel (Answer 8-9). The Appellants argue that those

15 limitations are not as broad as found by the Examiner.

16 As to claim 43, we agree with the Examiner. The Specification contains no

17 lexicographic definition of "appended," but the usual and customary meaning is

18 attached (FF 01 & 02). Claim 43 does not further limit the nature or proximity of

19 such attachment. Himmel's client side routine is a Javascript (FF 08), which is a

20 string of text placed within a web page that contains executable code. Since the

21 web page contains references to both itself and to advertisements within it, it

22 necessarily contains addresses to these, or URL's, in addition to whatever links

23 would almost certainly be present within the advertisements and on the web page.

24 Thus Himmel's client side routine is attached or appended to a URL. The

1 Appellants grouped claims 54 and 65 with claim 43 and we similarly sustain those

2 rejections.

3   As to claims 44-46 and 50, we agree with the Appellants. The Examiner

4 found that claims 44-46 were broad enough that some might be construed to be

5 associated with each event in the claim's limitation. However, the Examiner did

6 not find that such an association could be made for each event, i.e. every instance

7 of such an event, and we are unable to make such a finding. Thus, the Examiner

8 erred in rejecting claims 44-46. As to claim 50, the Examiner found that the claim

9 limitation of mouse pointer position data are used to achieve the in-view user

10 activities, and accordingly found that the data created by a mouse pointer met the

11 claim limitation. We disagree with the Examiner. Claim 50 depends from claim

12 40, and claim 40 requires that the collected data be sent to the web server. The

13 Examiner has made no finding that Himmel's mouse pointer position data are sent

14 to the web server, and we can find nothing in Himmel to make such a finding.

15   The Appellants grouped claims 55-57 and 66-68 with claims 44-46 and we

16 similarly do not sustain those rejections.

17   As to claim 48, the Examiner found the generation of billing records required

18 by that claim in Mason (Answer 5). The Appellants contend that Mason's

19 accounting records are not the same as billing records generated based on collected

20 data because Mason does not generate billing records (Br. 29). We disagree with

21 the Appellants. Mason describes billing an advertiser for an online newspaper ad

22 (FF 05) and using a statistical analysis package to monitor and report the success

23 of on-line advertisements and their derivative advertisements (FF 04). This

24 implies generating billing records based on the analysis of collected data. Claim

25 49 depends from claim 48 and is not separately argued, and we accordingly sustain

1   the rejection for claim 49 as well. The Appellants grouped claims 59, 60, 70, and

2   71 with claims 48 and 49 and we similarly do not sustain the rejections of those

3   claims.

<div align="center">CONCLUSIONS OF LAW</div>

5   The Appellants have sustained their burden of showing that the Examiner erred

6   in rejecting claims 44-46, 50, 55-57, 61, 66-68, and 72, but have not sustained their

7   burden of showing that the Examiner erred in rejecting claims 40-43, 48, 49, 51-

8   54, 59, 60, 62-65, and 70-71 under 35 U.S.C. § 103(a) as unpatentable over Mason

9   and Himmel.

<div align="center">DECISION</div>

11   To summarize, our decision is as follows:

12   • The rejection of claims 40-43, 48, 49, 51-54, 59, 60, 62-65, and 70-71 under

13   35 U.S.C. § 103(a) as unpatentable over Mason and Himmel is sustained.

14   • The rejection of claims 44-46, 50, 55-57, 61, 66-68, and 72 under 35 U.S.C.

15   § 103(a) as unpatentable over Mason and Himmel is not sustained.

16   No time period for taking any subsequent action in connection with this appeal

17   may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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<div align="center">AFFIRMED-IN-PART</div>

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